

Notice of Allowability

Application No.

09/473,662

Applicant(s)

RISEN ET AL.

Examiner

Art Unit

Nicholas D. Rosen

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment dated January 15, 2005.
2. ☒ The allowed claim(s) is/are 1,3,9-11,13-15,17,19,21 and 30-40.
3. ☒ The drawings filed on 17 July 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claims 1, 3-11, 13-15, 17, 19, 21, and 30-40 have been examined.

Allowable Subject Matter

Claims 1, 3, 9-11, 13-15, 17, 19, and 21 are allowed.

Claims 30-40 are allowed on essentially the same grounds.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Bennett ("Insuring against Patent Infringement"), discloses a method for providing an offer for financial protection, in the form of an insurance policy, against an unexpected change in value of an intellectual property asset, comprising (d) making an offer to provide compensation for at least a portion of any unexpected change in value of said at least one intellectual property asset to a person with an interest in a first party (third page of printed article; note statement, "The loss payable includes the diminution in value of the insured intellectual property caused by the infringement.") Bennett does not disclose computer-generating the offer, but Fox (U.S. Patent 4,766,539) teaches using a computer in generating an insurance offer to provide compensation (Figure; column 2, line 67, through column 3, line 51; column 7, lines 31-39). Bennett does not expressly disclose (a) obtaining a description of at least one intellectual property asset of a first party; (b) determining a value of said at least one intellectual property asset; and (c) determining a cost of providing compensation for an unexpected change in value of said at least one intellectual property asset, but it is well known practice to obtain descriptions of assets to be insured, determine the value of

such assets, and determine a cost of providing compensation for loss damage, etc., of such assets. However, neither Bennett nor Fox discloses (e) obtaining a first fee in exchange for offering to provide compensation (as a consulting fee, not an insurance premium). Friedman ("Class Outline: Economic Analysis of Law") teaches that the information that someone possessed of skill in evaluating risks and/or expert knowledge of the risks in a particular case has offered to insure an asset at a stated premium can be valuable even if the offer is not accepted (page 23, lines 24-28), and it is well known to pay consulting fees in exchange for valuable information, but these facts and teachings cannot plausibly be combined to make the particulars of the claimed invention obvious, in the absence of particular teachings of motivation, or any express disclosure of obtaining a first fee in exchange for merely offering to provide compensation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Whitworth (U.S. Patent 6,009,402) discloses a system and method for predicting, comparing, and presenting the cost of self insurance versus insurance and for creating bond financing when advantageous.

Hayden ("Fee for Service Idea Revamps Life Insurance Industry") discloses paying fees (instead of commissions) to insurance agents. Arkin ("An Insurance Consultant May Benefit Your Bottom Line") discloses insurance consultants providing advice for fees.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner's telephone number is expected to be changed to 571-272-6762 on or about April 13, 2005. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
April 5, 2005